REMARKS

This communication responds to the Office Action of March 24, 2008.

Double Patenting Rejection

Claims 56-58 were rejected under the judicially created doctrine of double patenting over claims 1 and 3 of U.S. Patent 6,735,329.

A Terminal Disclaimer in compliance with 37 CFR 1.321(c) is enclosed herewith to overcome these rejections.

Rejections Under 35 U.S.C. § 103

Claims 43-45, 47, 58, 75-82 and 84 are rejected under 35 U.S.C. § 103(a) over the combination of U.S. Patents 6,397,213 (Cullen), 6,804,684 (Stubler) and 6,031,526 (Shipp). Claims 46 and 83 are rejected under 35 U.S.C. § 103(a) over the combination of Cullen, Stubler Shipp and US Patent 6,529,617 (Prokoski). The rejections of the claims are traversed for at least the following reasons.

The cited references, when viewed alone or in combination, do not disclose or suggest the invention as claimed in claims 43, 47, 51, 56, 75, 81, and 84, in which a microprocessor compares a new image with a stored image and includes stored text associated with the stored image that is most similar to the new image in a document or medical record.

In contrast to the invention as claimed, Cullen discloses a document search and retrieval system in which:

> documents to be searched are "decomposed" into "zones," with each zone representing a grouping of text or graphical images or a combination thereof. The zones are generally defined within, and associated with a particular document page. One or more of the zones in the documents are selected for annotation with text (e.g., keywords), image features, or a combination of both. Document query and search are based on a combination of text annotations and image features. The invention can be used to search for text and images. As a simple example, the user can enter a text query, such as "sunset," and the system can return images of sunsets because they occur in documents (in the database) that contain the word "sunset" in close physical proximity to the image.

Cullen, col. 1, line 65 to col. 2, line 12. Cullen discloses decomposing documents into zones in order to provide query and searching capabilities. Cullen does not disclose that a microprocessor compares new images with stored images as provided in the pending claims. Furthermore, nowhere does Cullen disclose selecting the image zone annotation of a stored image for insertion into a document. More specifically, nowhere does Cullen disclose selecting the image zone annotation of a stored image that is most similar to an image of the query document for insertion into a medical record.

With respect to Cullen, the Examiner states: "Cullen does not go into detail about how the image portions are annotated when they are first entered into the database. Stubler discloses a method of generating captions or text annotations ...." *Office Action, page 5.* Rather, Cullen details how images are annotated where Cullen states:

> a text annotation is assigned to each of the zones in the document .
> . . For example, the text annotation assigned to an image zone
> includes texts from adjacent zones in addition to the picture
> caption . . . By using text from adjacent zones, a useful list of
> keywords can be generated even for zones that include no words
> (e.g., image zones) or few words (e.g., and "introduction"
> heading). Thus, for a document page that includes both text and
> one or more images, words are selected from the text and assigned
> to the image.

Cullen, col. 5, lines 34-46. Because Cullen does disclose, and thus details, how image portions are annotated, Cullen is not deficient in this regard, and one of skill in the art would not be inclined to turn to the cited art to determine how to annotate images. Accordingly, the Examiner's reasoning for combining Cullen with Stubler is improper.

Even if the combination of Cullen and Stubler were proper, Stubler does not remedy the deficiencies of Cullen. Stubler discloses:

> a method to assign captions or semantic levels to several images
> simultaneously based upon low-level objectively measurable
> similarities between the images. The advantage of this assignment
> is that it happens either automatically, or with limited user
> interaction, thereby decreasing the effort required of the user. A
> further advantage is that these semantic labels can subsequently be
> used as powerful tools for the storage, retrieval, and management
> of digital images within a digital image database environment.

Stubler, col. 3, lines 46-55. It is the intent of Stubler to group or cluster images together in a database environment. In Stubler, "[i]nitially, images are acquired (100), e.g., from a digital source such as the card reader 24 or the network interface 26, and metadata is extracted (110) from certain features in or related to the images." *Stubler, col. 6, lines 8-12.* "Acquired images are clustered or grouped by metadata similarity (120)." *Stubler, col. 7, lines 15-16.* "If similarities are found (130) between the acquired images and the database images, then the preexisting captions or semantic labels from the matched clusters and groups in the database are extended (140) to the acquired images." *Stubler, col. 8, lines 23-27.* Accordingly, in Stubler, preexisting captions or semantic labels are associated with acquired images. However, nothing in Stubler indicates that preexisting captions or semantic labels extended to images are also selected by a microprocessor for insertion into a document. More specifically, nowhere does Stubler disclose a microprocessor selecting preexisting captions or semantic labels of a stored image that is most similar to an image of the query document for insertion into a medical record.

With respect to Shipp, as an initial matter, the Examiner's reasoning for combining Shipp with Stubler and Cullen does not yield the invention as claimed. In the Office Action, the Examiner states: "It would have been obvious to one of ordinary skill in the art at the time of the invention to use the combined database and database creation taught by Cullen and Stubler to store medical records in order to make the records more organized and searchable." *Office Action, page 6.* There is no recitation in the independent claims that medical records are stored in a database or that medical records are searchable. Rather, the invention as claimed provides a library of stored images and a library of stored texts associated with each of certain stored images, so that once a new image is received, a microprocessor compares the stored image with the new image and selects for inclusion in a document or medical record the stored text associated with the stored image that is most similar to the new image. Accordingly, the combination of Shipp, Cullen and Stubler is not germane to the present application.

Furthermore, it is submitted that the Examiner finding a claimed element in a reference does not provide a sufficient rationale, teaching, suggestion or reason to combine. Shipp recites an electronic word processing document or a medical report stored in memory, and the Examiner asserts that this aspect can be combined with Cullen and Stubler to make records more organized and searchable to reach the invention as claimed. However, "[t]he 'as a whole' instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an

obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result—often the very definition of invention." *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004). Thus, the Examiner's piecemeal rejection of the independent claims under 35 U.S.C. §103 is improper.

Notwithstanding the improper combination of Shipp, Cullen and Stubler, Shipp fails to remedy the deficiencies of Cullen and Stubler. This is because Shipp discloses a voice controlled medical text image reporting system having a voice recognition module and image conversion software that allows images to be integrated into an electronic word processing document or medical report. In Shipp, the text associated with the images is "the text dictated by the surgeon." *Shipp, col. 4, lines 5-6.* Nothing in Shipp indicates text is selected for inclusion in a word processing document or medical report from stored text associated with a stored image that is most similar to the integrated images.

Prokoski, too, fails to remedy the deficiencies of Cullen, Stubler and Shipp. Instead, Prokoski discloses an imaging device that produces "a first signal representative of sensed characteristics of [an] individual and a minutiae generator which receives the first signal and produces a second signal representative of minutiae of the individual." *See Prokoski , Abstract.* A "minutiae matcher 106 compares the signals representative of person 101 to signals from minutiae database 102 corresponding to minutiae data of known persons." *Prokoski, col. 15, lines 35-37.* "If no known person meet the threshold requirement, a failure to match signal is produced." *Prokoski, col. 16, lines 43-45.* Even if Prokoski discloses generating a failure to match signal, Prokoski fails to teach or suggest a microprocessor that compares the new image to stored images and selects text for inclusion in a word processing document or medical report from stored text associated with a stored image that is most similar to the integrated images.

Dependent claims 44-46, 48-50, 52-55, 57-58, 76-80, and 82-83, which depend from their respective independent claims 43, 47, 51, 56, 75, and 81, are patentable for the reasons set forth above, and further in view of their additional recitations.

For at least the reasons set forth above, a *prima facie* case of obviousness required under 35 U.S.C. § 103 has not been established. Reconsideration and allowance are requested.

Conclusion

This response is being submitted on or before September 24, 2008, with the required fee of $525.00 for a three-month extension of time, making this a timely response. It is believe that no additional fees are due in connection with this filing. However, the Commissioner is authorized to charge any additional fees, including extension fees or other relief which may be required, or credit any overpayment, to Deposit Account No. 04-1420.

The application now stands in allowable form, and reconsideration and allowance are respectfully requested.

Respectfully submitted,

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